

REMARKS

Upon entry of the instant Amendment, claims 8 and 23 are canceled, claims 1, 2, 12 and 21 are amended, and claim 24 is added. Claims 1-7, 9-17, 21, 22 and 24 will be pending in the application with claims 1, 12 and 21 being independent. Support for the amendment to claims 1, 12 and 21 is provided in at least Fig. 1 of the drawings. No new matter is added. Reconsideration of the objections and rejections in view of the above amendments and the following remarks is respectfully requested.

Present Amendment is proper for entry

Applicants respectfully submit that the instant amendment is proper for entry after final rejection. Applicants note that no question of new matter is presented nor are any new issues raised in entering the instant amendment of the claims and that no new search would be required. Moreover, Applicants submit that the instant amendment places the application in condition for allowance, or at least in better form for appeal. Accordingly, Applicants request the Examiner to enter the instant amendment, consider the merits of the same, and indicate the allowability of the present application and each of the pending claims.

35 U.S.C. § 112, 2nd Rejection

Claim 23 was rejected under 35 U.S.C. § 112, second paragraph, for being allegedly indefinite.

By this Amendment, Applicants submit that this basis of rejection has been rendered moot at least because claim 23 has been canceled.

However, Applicants respectfully disagree with the Examiner's assertions of indefiniteness. The embodiments of Figs. 1-3 each shows an elongated mail sleeve with two or three sides and with opposite facing open ends. For example, in the embodiment of Fig. 1, one of the open sides is defined by a free edge of the end cap 103 (which extends only partially across the width of the wall 104) and the adjacent edge of the second wall 104 while the other open side is defined by the opposite edge (cut surface 106) of the first wall 102 and the corresponding edge of the second wall 104.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of the above-noted claims.

35 U.S.C. § 102 Rejection

Claims 21 and 22 were rejected under 35 U.S.C. § 102(b) for being allegedly anticipated by U.S. Patent No. 1,381,904 to CHRISTENSEN.

In order to establish a *prima facie* case of anticipation under 35 U.S.C. § 102, a single prior art reference must disclose each and every element as set forth in the subject claim. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). Applicants respectfully submit that a *prima facie* case of anticipation cannot be established because CHRISTENSEN fails to teach each and every element of the claims as amended.

More particularly, amended independent claim 21 recites, *inter alia*,

A flat mail sleeve packaging system having opposite facing open ends and being adapted to stack product with bound and non bound edges in a constrained homogenous mass, wherein one of the end caps extends partially across a width of the second constraining wall so as to define one of the opposite facing open ends.

Applicants submit that CHRISTENSEN does not disclose, or even suggest, at least these features. Applicants acknowledge, for example, that CHRISTENSEN teaches a parcel wrapper which has perpendicular walls 11 and 10 and which includes end portions 13 which are folded from wall 11 (see Fig. 3). Nor do Applicants dispute that the wrapper is disclosed as utilizing binding members 21 (see Fig. 1). However, it is apparent from Figs. 1-3 that the wrapper shown in Fig. 3 is specially designed with ends which are closed by portions 13 and 18. In contrast, the claimed invention is directed to a mail sleeve packaging system which has, among other things, opposite facing open ends.

Applicants also submit that the disclosed wrapper is unlike the instant invention in at least one important aspect. The invention provides that “the product can be unbound and set on an automatic feeder at a postal delivery facility without any further processing. In this manner, manual operations need not be performed on the stacks prior to mail sorting.” CHRISTENSEN, on the other hand, discloses a wrapper that is specifically designed for manual use. That is, the user places the parcels in the wrapper as necessary and installs binder 21 to hold the wrapper on the parcels. Such a device is clearly not designed or adapted for an automatic feeder.

Accordingly, Applicants respectfully submit that independent claim 21 as well as dependent claim 22, which depends from claim 21 are allowable.

Accordingly, Applicants respectfully submit that the rejection under 35 U.S.C. § 102(b) should be withdrawn.

35 U.S.C. § 102/103 Rejection

Claims 1, 2, 4, 5, 12, 14 and 16 were rejected under 35 U.S.C. § 102(b) for being allegedly anticipated by or alternatively were rejected under 35 U.S.C. § 103(a) for being allegedly unpatentable over by U.S. Patent No. 1,286,374 to McDONALD.

Applicants respectfully submit that a *prima facie* case of anticipation or obviousness cannot be established because McDONALD fails to disclose or suggest each and every element of the claims as amended.

More particularly, amended independent claims 1 and 12 each recites, *inter alia*,

A flat mail sleeve packaging system having opposite facing open ends and being adapted to stack product with bound and non bound edges in a constrained homogenous mass, wherein the end cap extends partially across a width of the second constraining wall so as to define one of the opposite facing open ends.

Applicants submit that McDONALD does not disclose, or even suggest, at least these features. Applicants acknowledge, for example, that McDONALD teaches a mail tray which has a first constraining wall A and a second constraining wall B and a first binding member E (see Fig. 1). However, it is clear from Fig. 1 of McDONALD that the disclosed mail tray has ends which are closed by walls C and D. Indeed, each end wall C and D extends across an entire width of the second wall B. In contrast, the claimed

invention is directed to a mail sleeve packaging system which has, among other things, opposite facing open ends which not completely closed by any end walls.

Applicants also submit that the disclosed mail tray is unlike the instant invention in at least one important aspect. The invention provides that “the product can be unbound and set on an automatic feeder at a postal delivery facility without any further processing. In this manner, manual operations need not be performed on the stacks prior to mail sorting.” McDONALD, on the other hand, discloses a tray that is specifically designed for manual use. That is, the user places the mail pieces of the tray, adjusts the plate D as necessary and tightens and loosens the strap E to remove and insert mail pieces. Such a device is clearly not designed or adapted for an automatic feeder.

Accordingly, Applicants respectfully submit that independent claims 1 and 12 as well as dependent claims 2, 4, 5, 14 and 16, which depends from claims 1 and 12 are allowable.

Accordingly, Applicants respectfully submit that the rejection under 35 U.S.C. §§ 102(b) and 103(a) should be withdrawn.

35 U.S.C. § 103 Rejection

Claims 3, 13 and 23 were rejected under 35 U.S.C. § 103(a) for being allegedly unpatentable over McDONALD in view of U.S. Design Patent No. 415,730 to JACOBSMEYER.

The Examiner acknowledges that McDONALD lacks, among other things, the recited second binding member. However, the Examiner explains that this feature is taught by JACOBSMEYER and that it would have been obvious to combine the teachings of these documents. Applicants respectfully submit that a *prima facie* case of obviousness has not been established as the applied references fail to teach each and every element of the claims.

Applicants submit that neither McDONALD nor JACOBSMEYER disclose or suggest the combination of features recited in at least independent claims 1 and 12, from which claims 3 and 13 depend. Applicants also submit that no proper combination of these documents disclose or suggest the combination of features recited in at least claims 1 and 12.

As explained above, the end walls C and D of McDONALD close the end openings of the mail tray and do not provide for opposite facing end openings.

Additionally, while the Examiner has identified the perpendicularly arranged binding members in Figs. 9 and 10 of JACOBSMEYER, it is clear that the design shown in JACOBSMEYER lacks any end caps, much less, that a portion of one of the first and second constraining walls that is folded over to form an end cap that is adapted to protect an end product of the stack and add rigidity to the flat mail sleeve packaging system.

Moreover, in addition to failing to disclose the combination of features recited in the above-noted claims 1 and 12, Applicants submit no proper combination of these

documents discloses or suggests the combination of features recited in claims 1 and 12 or in the above-noted claims 3 and 13 which depend from claims 1 and 12.

Accordingly, Applicants respectfully submit that the above-noted rejection under 35 U.S.C. § 103(a) should be withdrawn.

Request for Rejoinder of Non-Elected Claims

Applicants further submit that rejoinder of withdrawn claims is now proper, because the withdrawn claims depend from claims 1 and 12 which are believed to be allowable.

Applicants refer the Examiner to MPEP 821.04 which indicates that withdrawn claims which depend from or otherwise include all the limitations of the allowable claims will be rejoined if presented prior to allowance and issuance of a final rejection.

Accordingly, Applicants request that the Examiner rejoin these claims directed to the non-elected invention and consider the merits of the same.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue.

The Examiner is invited to contact the undersigned at the telephone number listed below, if needed.

Respectfully submitted,
B. H. HANSON, *et al.*

A handwritten signature in black ink, appearing to be 'Andrew M. Calderon', with a stylized, sweeping flourish at the end.

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